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10/811,660	03/29/2004	Patrick Thomas McQuary		2446

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Mr. Patrick Thomas McQuary
29 Orsinger Hill
San Antonio, TX 78230

EXAMINER

MEINICKE DIAZ, SUSANNA M

ART UNIT	PAPER NUMBER
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3692

MAIL DATE	DELIVERY MODE
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10/30/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/811,660

Applicant(s)

MCQUARY, PATRICK THOMAS

Examiner

Susanna M. Diaz

Art Unit

3692

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 July 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/ICE)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. This final Office action is responsive to Applicant's amendment filed July 23, 2008.

Claims 1-3 are presented for examination.

Response to Amendment

2. The previously pending claim objection is withdrawn in response to Applicant's amendment of claim 1.

The previously pending 101 and 112, 2nd paragraph rejections are withdrawn in response to Applicant's amendment of claims 2 and 3.

Response to Arguments

3. Applicant's arguments filed July 23, 2008 have been fully considered but they are not persuasive.

Applicant argues, "Although **Wilkinson** (U.S. Patent No. 5,863,074) has a similar purpose as the **McQuary** application here, it is based on a computerized system and method to enter, edit, store and retrieve payee identification data, **McQuary** is a much simpler system and method which does not require a computer or even a database. Instead the data in **McQuary** is only that which is contained in the payor's government issued identification card which is superimposed as an identical copy on the payor's check." (Page 9 of Applicant's response) While the language of claim 1 is broadly open to interpretation as a purely human-implemented method, it does not preclude

anticipation by prior art teachings that perform the recited method using a computerized system. The claim limitations do not preclude use of a computer or database; therefore, Applicant's argument is not persuasive.

Applicant argues, "**Wilkinson** makes no mention of copying the identification card with its picture to the negotiable instrument. Instead, it only addresses the transfer of identifying data to the negotiable instrument." (Page 9 of Applicant's response) There is no step of copying recited in claims 1-3; therefore, it is not clear which limitation(s) Applicant asserts are not taught by the prior art.

In regard to the Brikho reference, Applicant continues to argue that Brikho's invention is computer-implemented, while the claimed invention requires no computers (pages 9-10 of Applicant's response). Again, the claimed invention does not incorporate limitations that explicitly exclude use of a computer or database. The claimed invention is open to being implemented manually or through a computerized system or a combination thereof. (Furthermore, as seen in the rejection under § 101 below, since the claimed invention is open to being performed manually, the claimed invention is non-statutory.)

Applicant makes similar arguments for the Farrar reference. Again, the use of a computer to implement a process anticipates the process, unless the claim specifically excludes use of a computer (which is currently not the case with claims 1-3). Even if the claims were amended to explicitly preclude use of a computer, then the current rejections under 35 U.S.C. 101 would likely still apply. Also, it is noted that performing a previously automated process by hand has certain old and well-known benefits, such as

improved customer relations and more flexibility in making decisions. These benefits would be considered if Applicant were to explicitly amend the claims to preclude use of a computer in the claimed invention.

In summary, Applicant's arguments are not persuasive and the art rejection is maintained. New rejections under 35 U.S.C. 101 and 112 have been added below.

Specification

4. The amendment filed July 23, 2008 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows:

The new material added to the specification is all underlined and found on new pages 9-11 of the specification. It appears that this new material should have been introduced as arguments instead. Please remove this new matter from the specification. At present, the Examiner will address this new matter as arguments.

Applicant is required to cancel the new matter in the reply to this Office Action.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 2-3 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 2 is directed toward a system. System claims are defined by their structural elements; however, recited system elements include a "card," "an image" and a "comparison." It is not clear what structural metes and bounds are attributed to a card, image, or a comparison; therefore, limitations (a), (b), and (c) of claim 2 are vague and indefinite. A card could simply be the data on a card (e.g., printer matter *per se*). Similarly, an image is effectively a collection of data and a comparison implies a step.

Claim 3 is directed toward a system. System claims are defined by their structural elements; however, recited system elements include "an image." It is not clear what structural metes and bounds are attributed to an image (for the aforementioned reasons); therefore, the limitations of claim 3 are vague and indefinite.

Appropriate correction is required.

Claim Rejections - 35 USC § 101

7. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

8. Claims 1-3 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Comiskey explains that mental processes *per se* are not statutory under § 101. Mental processes must be tied into some other category of statutory subject matter in

order to be potentially patentable under § 101. *Comiskey* specifically states, "However, mental processes -- or processes of human thinking -- standing alone are not patentable even if they have practical application." (See *In re Comiskey*, 84 USPQ2d, at 1678) *Comiskey* continues with the rationale that "the patent statute does not allow patents on particular systems that depend for their operation on human intelligence alone, a field of endeavor that both the framers and Congress intended to be beyond the reach of patentable subject matter. Thus, it is established that the application of human intelligence to the solution of practical problems is not in and of itself patentable." (See *In re Comiskey*, 84 USPQ2d, at 1679) Claim 1 is directed toward a mental process that is reliant on the operation of human intelligence and the process is not sufficiently tied to another statutory class nor does it transform underlying subject matter to a different state or thing; therefore, claim 1 does not fall into one of the statutory categories recognized as patentable under 35 U.S.C. § 101. By Applicant's own admission, "no database or computer is necessary to implement the **McQuary** patent." (Page 9 of Applicant's response)

Claim 2 recites a system that comprises a card, an image, and a comparison, neither of which is statutory. A card and an image can be broadly interpreted as data *per se*. Furthermore, a comparison implies a method step and this step may be performed in the mind of a human user. Claim 2 fails to recite statutory subject matter.

Claim 3 recites a system that comprises an image. An image can be broadly interpreted as data *per se*. Claim 3 fails to recite statutory subject matter.

Appropriate correction is required.

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 1-3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wilkinson (U.S. Patent No. 5,863,074) in view of Brikho (US 2004/0026500 A1) in view of Farrar et al. (U.S. Patent No. 6,647,376).

Wilkinson discloses a method for identification of a payor of a negotiable instrument by a merchant payee, comprising the steps of:

[Claim 1] (a) the step of preparing printed checks or other negotiable instruments for the payor's signature, superimposed with an identical image of the payor that is to be used by the payor as identification when presenting said negotiable instrument to payee (Figs. 1-4; col. 4, lines 37-45);

(b) the step of the payor presenting said negotiable instrument with an image of payor's photographic identification superimposed (col. 6, lines 4-7); and,

(c) the step of the merchant payee identifying the payor by verification of the identifying information on the negotiable instrument by comparison with that information on the photographic identification provided by the payor (col. 6, lines 4-7 – The photograph of the payor should resemble the payor him/herself).

Wilkinson does not expressly disclose that the printed checks or other negotiable instruments are printed by the payor's financial institution; however, the manipulative steps and structural elements of the claimed invention are not affected by who prints the checks. Therefore, the details of who prints the checks will not serve to patentably distinguish the claimed invention over the prior art.

While Wilkinson prints a check payor's photograph on the payor's checks and such an image may be input through a scanner (col. 5, lines 20-23), Wilkinson does not expressly state that the photograph is obtained from a government issued photographic identification card; however, Brikho also discloses the concept of imprinting a payor's photograph on checks to prevent fraudulent check writing (abstract; ¶ 62). Brikho states that the imprinted picture may be "scanned in from the customer's drivers' license" (¶ 62), which is a government issued photographic identification card. Since Wilkinson is expressly amenable to using scanned photographs of the check payor, the Examiner submits that it would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to modify Wilkinson to expressly utilize a photograph of the payor from the payor's drivers license (i.e., a government issued photographic identification card) since drivers license photos are more standardized in nature and are harder to falsify than a random, personal photograph, thereby providing merchants with a more commonly recognized and trustworthy system of verifying payors' identities.

Additionally, neither Wilkinson nor Brikho expressly teaches that the photograph on the payor's check is further verified against the payor's photograph on an actual government issued photographic identification card. However, Wilkinson describes

itself as an improvement over the previous check authentication method of identifying a person cashing a check (col. 1, lines 23-27). Also, Farrar discloses that a merchant can request that a check payor present his/her drivers license as an additional identity verification, thereby improving confidence in the determination that the payor is authorized to write the check (col. 22, lines 8-15). This practice helps to assure the merchant that the check is legitimate. Also, many merchants note the drivers license number on the check itself in case there is a problem with cashing the check, so that any problems with payment may be rectified later. Therefore, the Examiner submits that it would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to modify the Wilkinson-Brikho combination such that a merchant payee further verifies the payor's identification by comparing the check or other negotiable instruments with the information on the actual photographic identification provided by the payor in order to increase the security measures in identifying the payor while helping to ensure the merchant that the check is legitimate and providing the merchant with a way to track down the payor if there is a problem with cashing the check, so that any problems with payment may be rectified later.

[Claims 2-3] Claims 2-3 recite limitations already addressed by the rejection of claim 1 above; therefore, the same rejection applies.

Conclusion

11. An examination of this application reveals that applicant is unfamiliar with patent prosecution procedure. While an inventor may prosecute the application, lack of skill in this field usually acts as a liability in affording the maximum protection for the invention disclosed. Applicant is advised to secure the services of a registered patent attorney or agent to prosecute the application, since the value of a patent is largely dependent upon skilled preparation and prosecution. The Office cannot aid in selecting an attorney or agent.

A listing of registered patent attorneys and agents is available on the USPTO Internet web site <http://www.uspto.gov> in the Site Index under "Attorney and Agent Roster." Applicants may also obtain a list of registered patent attorneys and agents located in their area by writing to the Mail Stop OED, Director of the U. S. Patent and Trademark Office, PO Box 1450, Alexandria, VA 22313-1450.

12. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the

shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Susanna M. Diaz whose telephone number is (571) 272-6733. The examiner can normally be reached on Monday-Friday, 8 am - 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kambiz Abdi can be reached on (571) 272-6702. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Susanna M. Diaz/
Primary Examiner, Art Unit 3692